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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,654	05/03/2001	Roderic M. K. Dale	033995-0143	9139

9629 7590 06/17/2003

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EXAMINER

KRISHNAN, GANAPATHY

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 06/17/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,654

Applicant(s)

DALE ET AL.

Examiner

Ganapathy Krishnan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

An election/ restriction (Paper # 7) in the instant case was mailed December 6, 2002. The applicants responded to this election/ restriction (paper #8) on April 4, 2003 and indicated election of Group I, claims 1-15 and 30-36 with traverse. After perusal of the claims the Examiner decided to recast the restriction and called the attorney of record, Mr. Robert Smyth on May 15, 2003 and informed him of the rerestriction. Mr. Smyth requested that he would like to see the rerestriction in writing and would like to respond after reviewing it. Hence, a recast restriction of the instant claims is contained herein below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 31 and 32, drawn to antimicrobial compositions comprising protonated compounds comprising the structure X-Y-Z, classified in class 514, subclass 108.
- II. Claims 16-20, drawn to antimicrobial compositions containing a five membered heterocyclic ring, classified in class 514, subclass 42.
- III. Claims 21-23, drawn to antimicrobial compositions containing a deoxyribose ring, classified in class 514, subclass 50.
- IV. Claims 24-29, drawn to antimicrobial compositions containing a ring with one or two heteroatoms, classified in class 536, subclass 1.11.
- V. Claims 30 and 36, drawn to method of treating a microbial infection and sanitizing a surface, classified in class 514, subclass 75.

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VI Claims 33-35, drawn to a surface having a coating of the compound comprising the structure X-Y-Z, classified in class 514, subclass 314.

Inventions II-IV and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Group I drawn to bisphosphates are structurally unrelated to the inventions of Groups II-IV, which are drawn to nucleotides. The search required for Group I is not required for Groups II-IV.

Inventions V and VI and I-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the surface having a coating and the method of treating microbial infection and sanitization can be practiced with haloperoxide containing compositions as disclosed by Allen (US 5510104).

Inventions III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Group II drawn to compositions containing a heterocyclic ring with different heteroatoms in the ring and different substituents in the 1' and 2' positions are structurally

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different from inventions of Group III, which are drawn to compositions containing deoxyribose with a uracil and hydrogen substitutions at the 1' position.

Inventions IV and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Group IV which are drawn to compositions containing a heterocyclic ring with different hetero atoms and different substitutions at the 1' position are structurally different from the inventions of Group II drawn to compositions containing a heterocyclic ring with different heteroatoms in the ring and different substituents in the 1' and 2' positions.

Inventions IV and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Group IV which are drawn to compositions containing a heterocyclic ring with different heteroatoms and different substitutions at the 1' position are structurally different from the inventions of Group II which are drawn to compositions containing deoxyribose with a uracil and hydrogen at the 1' position.

Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Group V drawn to a method treating microbial infections and sanitizing a surface have different modes of operation and different functions compared to invention of Group V which is drawn to coated surface.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

It would indeed impose an undue burden upon the examiner in charge of this application if the instant restriction and species requirements are not advanced as set forth herein.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

In the event the applicants elect the invention of Group II, applicants are further required to respond to the following species requirement:

Species A: Q = O, S classified in class 536

Species B: Q = P, classified in class 568

Species C: Q = N, classified in class 548

Group III will be examined with Group II for Q = O, S only.

Should applicants elect the invention of Group IV, applicants are required to elect either the five membered ring formula containing one hetero atom (Q) in the ring or the six membered ring formula with two hetero atoms (Q and V) in the ring in claim 24 and respond to the following species requirement:

Species A: Q = O, S and V = H, classified in class 536

Species B: Q = V = P, classified in class 568

Species C: Q = V = N, classified in class 548

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

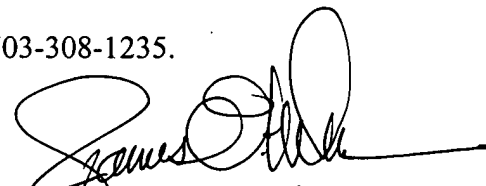
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 703-305-4837. The examiner can normally be reached on 8.30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

June 16, 2003



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600